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OFFICE OF PETITIONS

In re Application of
Tricia J. Vos et al
Application No. 10/727,997
Filed: December 4, 2003
Attorney Docket No. 29984-208422

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:
: DECISION GRANTING PETITION
: UNDER 37 CFR 1.313(c)(2)
:

This is a decision on the petition, filed September 6, 2007, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on June 22, 2007 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.¹

It is noted that petitioner requests the Office to withdraw this application from issue under the provisions of 37 CFR 1.313(b)(1) "because a mistake was made on the part of the USPTO."

37 CFR 1.313(b) states:

Once the issue fee has been paid, the Office will not withdraw the application from issue at its own initiative for any reason except:

¹ The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s) Transmittal Form (along with any balance due at the time of submission). Petitioner is advised that the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment.

- (1) A mistake on the part of the Office;
- (2) A violation of § 1.56 or illegality in the application;
- (3) Unpatentability of one or more claims; or
- (4) For interference.

37 CFR 1.313(c) states:

Once the issue fee has been paid, the application will not be withdrawn from issue upon petition by the applicant for any reason except:

(1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;

(2) Consideration of a request for continued examination pursuant to § 1.114; or

(3) Express abandonment of the application. Such express abandonment may be in favor of a continuing application.

37 CFR 1.313(d) states:

(d) A petition under this section will not be effective to withdraw the application from issue unless it is actually received and granted by the appropriate officials before the date of issue. **Withdrawal of an application from issue after payment of the issue fee may not be effective to avoid publication of application information** (emphasis added).

37 CFR 1.313(b) applies to those situations where the Office, **at its own initiative**, may withdraw an application from issue, but only in those situations which meet the conditions of 37 CFR 1.313(b). See Sampson v. Dann, 466 F.Supp. 965, 973-74, 201 USPQ 15, 22 (D.D.C. 1978). Therefore, 37 CFR 1.313(b) is inapplicable here since the rule does not provide for withdrawal from issue at the request of an applicant.


Additionally, petitioner should note that, where applicant seeks to correct an error or submit an amendment after allowance of the application, such

amendment must be submitted in accordance with 37 CFR 1.312. As set forth in 37 CFR 1.312, no amendment may be made as a matter of right in an application after the mailing of the notice of allowance.

The proper avenue of relief for withdrawing an application from issue after payment of the issue fee is by way of a petition under 37 CFR 1.313(c)(1)-(3). Therefore, this application can only be withdrawn from issue at the request of the applicant under one of the provisions set forth in 37 CFR 1.313(c)(1)-(3). The petition meets the conditions of 37 CFR 1.313(c)(2).

Telephone inquiries should be directed to the undersigned at (571) 272-3218.

This matter is being referred to Technology Center AU 1626 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the Information Disclosure Statement.


Frances Hicks
Petitions Examiner
Office of Petitions